



ITW

Application of:) METHOD OF PLAYING GOLF
)
BRADLEY EMALFARB)
)
Ser. No.: 10/806,653) Group Art Unit: 3711
)
Filed: March 23, 2004)
) Examiner R. Gorden

REQUEST FOR RECONSIDERATION

Commissioner For Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Sir:

37 CFR 1.8
CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on 10-27-06 (date).

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Claims 1-8 and 11-18 are currently pending in the application. Applicant gratefully acknowledges the allowance of claims 13-18.

Claims 1-8, 11 and 12 stand rejected under 35 U.S.C. §103 as obvious over U.S. Patent No. 6,358,160 (Winskowicz).

Reconsideration of the rejection of claims 1-8, 11 and 12 is requested.

IN THE BACKGROUND OF THE INVENTION section of Winskowicz, the problem addressed by Winskowicz' invention is set forth. In summary, an entire industry has developed in the sale of second hand golf balls that have been lost by the initial purchasers in water holes, and the like. While golf balls are affected by submersion in water, they can be recovered after submersion for as long as six months with altered performance characteristics that would not be detectable to an average golfer. This is consistent with Winskowicz' data. Winskowicz cites data suggesting that a golf ball will loose distance on the order of 15 yards after submersion for six months.

As a result, those in the second hand golf ball industry can offer used golf balls that have been immersed at a relatively high price. This relatively high price may be gotten whether the period of immersion is relatively short, such as a matter of days, or extended, such as on the order of six months or more. A prospective purchaser of a used golf ball would not be able to visually inspect a conventional ball and make any meaningful type of determination as to whether the golf ball had been immersed in water at all and, if so, whether the immersion was for a very short period or an extended period.

Hence, Winskowicz developed a golf ball that would visually alert a prospective purchaser thereof that the same had been immersed for a long period of time. Winskowicz states "such an indicator is used to alert golfers to potential changes in ball properties due to long water exposure times". Winskowicz' invention is premised on a

well accepted fact that long water exposure times, on the order of six months or more, would change performance, but only to a degree that would not be detectable to an average golfer. A purchaser of a used golf ball may not realize that the golf ball, which may have been immersed in water for six months or more, has lost a significant amount of carry i.e. on the order of 15 yards. Thus, that individual would be playing with a compromised golf ball but would not have any appreciation of this fact. The golf ball in that state is nonetheless clearly recognized to be practical to use in playing a round of golf.

The Examiner states on page 2 of the Acton that “Winskowicz discloses a golf ball that **changes performance characteristics** once immersed in water for several days” (our emphasis-col.2). Applicant respectfully disagrees. Winskowicz teaches a golf ball that provides a visual indication as to potential changes in ball properties due to long water exposure time (col. 2, lines 7-9). To do this, the ball is made with water-activated transparent ink which appears when it is exposed to water for long periods of time (see also col. 2, lines 1-4).

There is nothing in Winskowicz’ disclosure of his invention that suggests that any corresponding performance characteristic is changed by reason of his inventive structure, other than what is inherent to any conventional golf ball, as described in the BACKGROUND OF THE INVENTION portion of the Winskowicz patent.

Conceivably, one could take Winskowicz’s golf ball, with the transparent ink activated, and use the same to play golf. With applicant’s structure, submersion within a specific time range will cause change in the characteristics of the golf ball **so that it cannot practically be used to play golf**. Independent claims 1 and 4 expressly include this limitation.

On page 3 of the Action, the Examiner states "[t]he prior art clearly discloses applicant's claimed invention. The prior art and the present invention disclose golf balls having a first characteristic and a different characteristic once immersed in water for several days". Again, applicant respectfully disagrees with this statement. Claims 1 and 4 specifically recite first and second performance characteristics related to the **performance** of the ball, not its **appearance**, as taught by Winskowicz'.

Claim 2, for example, characterizes the period of immersion within which the golf ball performance characteristics change as greater than 2 days and less than 30 days. The change is to such an extent that **it is impractical to use the golf ball** with the second performance characteristic to play golf.

In describing the prior art, Winskowicz does not mention any significant and detectable change in a golf ball characteristic resulting from immersion less than 30 days. For Winskowicz's own inventive golf ball, there is no change described with respect to performance characteristics attributable to the invention.

Accordingly, claims 1 and 4, and their dependent claims are believed allowable. Reconsideration of the rejection of claims 1-8, 11 and 12 and allowance of the case are requested.

Respectfully submitted,

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